

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** MATTHEW R. SIEGEL

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Appeal No. 1998-0724  
Application No. 08/231,287

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HEARD: October 12, 2000

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Before BARRETT, RUGGIERO, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-4, 8, 11  
and 12, which are all of the claims pending in this application.

We REVERSE.

## BACKGROUND

The appellant's invention relates to a method and system for providing multiple entry point code resources. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. In a computer system, the computer system having a multiple entry point code resource, the multiple entry point code resource comprising a main code resource and an auxiliary code resource, the main code resource having global variables, the auxiliary code resource having functions, a method for initializing an auxiliary code resource comprising the computer-implemented steps of:

loading the auxiliary code resource into memory;

searching the loaded auxiliary code resource for a sequence of markers; and

storing a reference to the global variables into the sequence of markers so that when a function is invoked, the function can access the global variables using the stored reference.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Walsh	5,375,241	Dec. 20, 1994 (Filed Dec. 21, 1992)
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Lefor et al., "Reaching into expanded memory (software design to access expanded memory)", **PC Tech Journal**, vol. 5, no. 5, pp. 100-115 (May 1987) (Lefor).

DiLascia, "Questions and Answers: C/C++", **Microsoft Systems Journal**, vol. 8, No. 7, pp 83-88 (July 1993).

Claims 1, 8, and 11<sup>1</sup> stand rejected under 35 U.S.C. § 103 as being unpatentable over Walsh in view of DiLascia. Claims 2-4, and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Walsh and DiLascia further in view of Lefor.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 17, mailed Mar. 14, 1997) and the supplemental examiner's answer (Paper No. 20, mailed Jun. 2, 1997) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 16, filed Feb. 11, 1997), reply brief (Paper No. 18, filed May 19, 1997) and supplemental reply brief (Paper No. 21, filed Jul. 17, 1997) for the appellant's arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

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<sup>1</sup> We note that the examiner merely cut and pasted the final rejection into the answer without correcting the claims that are rejected. Claims 5, 6, 7, 9, 10, and 13 have been canceled by the after final amendment filed Sep. 23, 1996. In an advisory action, mailed Oct. 2, 1996, the examiner indicated that the amendment would be entered upon filing of the appeal, but the amendment has not been officially entered at this time. We shall address only those claims remaining in the case after entry of the amendment.

Appellant argues that the examiner's determination of unpatentability is improper and the examiner has not evaluated the claimed invention under the proper obviousness principles and standards to set forth a ***prima facie*** case of obviousness. (See brief at page 12 and reply brief at page 8.) We agree with appellant.

In the supplemental answer, we note that the examiner goes on at length about the motivation to combine "underlying software concepts" (see supplemental answer at page 2), reuse of portions of programs (see supplemental answer at page 3), principle of stare decisis (**Id.**), software is "*profoundly distinguished*" and the examiner "bears a difficult and substantial burden" in examining software related patent applications (see supplemental answer at page 4), the standard for obviousness and hindsight (see supplemental answer at pages 5-6), the invention must "clearly distinguish" over the prior art (see supplemental answer at page 6), "all reasonable interpretations" of the claim language (see supplemental answer at page 7), and the examiner's summary of the invention and opinion on patentability. Similar discussions are made throughout the answer.

To summarize our opinion, we find that the examiner's rejection is not solidly based upon the prior art references which he has relied upon in the rejection. It is clear to us that the examiner strongly believes that the claimed invention should not be

patentable. Be that as it may, it is the duty and obligation of the examiner to examine each application; perform a search of the most relevant areas where relevant prior art is most likely to be located; select the most relevant prior art, in the examiner's opinion; and present a ***prima facie*** case of anticipation or obviousness to reject a claim, if appropriate, based upon those most relevant prior art teachings. Otherwise, that claim is allowable over the prior art of record.

Here, the examiner has found prior art references which arguably disclose portions of the claimed invention. (See answer at page 3-10.) In the text of the rejections the examiner never specifically addresses the language of any of the independent claims, but merely argues the general concepts and the knowledge of those skilled in the art. We disagree with the examiner's conclusions concerning the claimed invention and find that the examiner has not set forth a ***prima facie*** case of obviousness.

While we agree with the examiner that underlying software concepts used in disparate technologies may be properly combined, the examiner must set forth a convincing line of reasoning for the skilled artisan to look to those disparate technologies to find relevant teachings and to combine these teachings.

Further, we agree with the examiner that those skilled in the art of computer programming do reuse portions of programs to perform specific functions, but we find that

the examiner has not addressed the specific language of the claimed invention and applied any specific portions of the prior art references thereto.

With respect to the principle of ***stare decisis***, we disagree with the examiner's proposition in the examination of patent applications. First, the examiner is only a quasi judicial official, at most, and does not have the authority to disregard the law or regulations, as he deems appropriate. He, and this Board are bound to follow binding precedent. Second, the case cited by the examiner is from the Supreme Court of Pennsylvania which is not binding precedent. Therefore, this argument is not persuasive.

We agree with the examiner that software related inventions are “*profoundly distinguished*” from other areas of technology because of the abstract nature of the inventions and the lack of published prior art in this area. Furthermore, we agree with the examiner that an examiner in this area “bears a difficult and substantial burden” in examining software related patent applications, but that difficulty does not change the review standard for obviousness. The same objective standard is applied to each claimed invention, taken as a whole, no matter what the technology the invention is based upon.

In determining whether a claim would have been obvious at the time of the invention, the Examiner must first determine the scope and content of the prior art. **Graham v. John Deere Co.**, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). “Although

§ 103 does not, by its terms, define the 'art to which [the] subject matter [sought to be patented] pertains,' this determination is frequently couched in terms of whether the art is analogous or not, i.e., whether the art is 'too remote to be treated as prior art.'" **In re Clay**, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992) citing **In re Sovish**, 769 F.2d 738, 741, 226 USPQ 771, 773 (Fed. Cir. 1985).

In making this determination, we must consider two criteria. First, it must be determined whether the prior art is from the same field of endeavor, regardless of the problem addressed. Second, even if the prior art is not in the same field of endeavor, it must be determined whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. **In re Clay**, supra, 966 F.2d at 658-659, 23 USPQ2d at 1060. With respect to the field of endeavor, there is little dispute that the prior art references are not within the same specific field of endeavor, i.e., multiple entry point code resources. However, prior art references may still be analogous if it is "reasonably pertinent to the particular problem with which the inventor is involved." **Id.**

See also **In re Paulsen**, 30 F.3d 1475, 1481, 31 USPQ2d 1671, 1675-76 (Fed. Cir. 1994). Here, we find that the prior art references are not reasonably pertinent to the particular problem with which the inventor is involved. Therefore, the underlying general software concepts are not properly combinable based upon the rationale set forth by the examiner.

Moreover, we disagree with the examiner's argument that the invention must "clearly distinguish" over the prior art of record. All that is required is that the prior art does not anticipate or render obvious the claimed invention as delimited by the language of the claim and as properly interpreted in light of the disclosure. This interpretation does not include all interpretations, but only those that are reasonable interpretations in light of the relevant disclosure and any applicable file wrapper estoppel. Here, the examiner has merely set forth that the language of the claims is broad and therefore, his interpretation thereof is similarly broad and a wider range of prior art teachings are applicable to the claimed invention. Still, the examiner does not address the specific language of the claims and only discusses general concepts rather the metes and bounds of the claimed invention.

As discussed above, we find that the examiner has not set forth a ***prima facie*** case of obviousness, and we will not sustain the rejection of independent claims 1, 8 and 11 based on Walsh and DiLascia.

Since Lefor does not remedy the deficiency in the combination of Walsh and DiLascia, we will not sustain the rejection of independent claims 2, 4 and 12 and dependent claim 3 based on Walsh, DiLascia and Lefor.

## **CONCLUSION**



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To summarize, the decision of the examiner to reject claims 1-4, 8, 11 and 12 under  
35 U.S.C. § 103 is reversed.

**REVERSED**

LEE E. BARRETT  
Administrative Patent Judge

JOSEPH F. RUGGIERO  
Administrative Patent Judge

JOSEPH L. DIXON  
Administrative Patent Judge

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